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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Masahiro SAKURADA et al.

Group Art Unit: 2818

Application No.: 10/500,580

Examiner: C. LEE

Filed: July 1, 2004

Docket No.: 120222

For: AN SOI WAFER AND A METHOD FOR PRODUCING AN SOI WAFER

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In a Restriction Requirement mailed September 15, 2005, restriction was required between Group A (claim 19, drawn to a process of producing an SOI wafer) and Group B (claims 1-18, drawn to an SOI wafer).

In response to the Restriction Requirement, Applicants hereby elect Group B, claim 1-18. This election is made with traverse for the following reasons:

Applicants respectfully assert that the Requirement is improper because the instant application is the national stage of a PCT application, and the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT national stage applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." *See* MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept." *See* MPEP §1893.03(d). (emphasis added). If multiple inventions are included in the

application, they are deemed to be linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." *See* MPEP §1893.03(d).

In situations in which claims to a product and a process for making that product are present in a PCT national stage application, unity of invention exists if the process is "specially adapted for the manufacture of the process." *See* MPEP §1850. That is, there is unity of invention if the product inherently results from the process and the same special technical relationship is claimed in both. In this application, Groups A and B are linked by a single general inventive concept that involves a common special technical feature. The special feature common to all claims is that the "silicon active layer consists of silicon single crystal grown by Chochralski method, which is occupied by N region outside OSF generated in a shape of a ring and has no defect region detected by Cu deposition method." Thus, as set forth in Example 1 of Annex B, Part 2, of the Administrative Instructions under the PCT, unity of invention exists between Groups A and B.

However, the Office Action does not contain an explanation of why Groups A and B lack unity that specifically describes a unique special technical feature of each group. *See* MPEP §1850. Rather, the Office Action merely asserts that Groups A and B are related as a process of making and product made, and that Groups A and B are distinct because the products of Group B can be made by a materially different process than that of Group A.

The Office Action appears to have focused on the ability to produce the product of Group B by methods other than the process of Group A to the exclusion of all other considerations. Applicants respectfully point out that the expression "specifically adapted" should not be construed to exclude the manufacture of the product by variations of a single process or even different processes. *See* MPEP §1850. The fact that variations of a method

may be used to produce a particular product, does not in and of itself establish that a lack of unity of invention exists.

As long as a common technical feature and single general inventive concept applies to the asserted group of claims, unity of invention exists and restriction cannot be required. In this case, each of the process claims are linked by at least the product as a special technical feature. This relationship is sufficient to support the unity of invention between these claims.

Thus, because the Office Action has not properly demonstrated an absence of unity of invention under the rules, and because unity of invention in fact exists between Groups A and B, the Restriction Requirement is improper and must be withdrawn. Reconsideration and withdrawal of the Requirement are respectfully solicited.

Respectfully submitted,



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WPB:JMS/brc

Date: October 14, 2005

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